



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/734,992	12/12/2000	Anuj Jain	ERIC P12549	3370

7590 06/13/2003

DAVID E. BENNETT
COATS & BENNETT P.L.L.C.
1400 CRESCENT GREEN
SUITE 300
CARY, NC 27511

EXAMINER

NAJJAR, SALEH

ART UNIT PAPER NUMBER

2157

DATE MAILED: 06/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/734,992

Applicant(s)

JAIN, ANUJ

Examiner

Saleh Najjar

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,7. 6) ☐ Other:

Art Unit: 2157

1. This action is responsive to the application filed on December 12, 2000. Claims 1-25 are pending. Claims 1-25 represent a method, system and product for controlling inclusion of email content.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Ogilvie et al., U.S. Patent No. 6,487,586.

Ogilvie teaches the invention as claimed including a self-removing email, verified or designated as such by a message distributor for the convenience of a recipient (see abstract).

As to claim 1, Ogilvie teaches a method of controlling inclusion of email content comprising:

selecting at least a portion of an email message as excluded content (see figs. 2-3; col. 5, lines 10-25, Ogilvie discloses a system where the sender selects all or portion of a message to be self removing);

transmitting said email message to a recipient configured to exclude said excluded content from a message originating from said recipient (see col. 5-6, Ogilvie discloses that a message contains code identifying some or all of message content to be self-removing).

As to claim 2, Ogilvie teaches the method of claim 1, wherein said message originating from said recipient is a reply to said email message (see col. 14-15).

As to claim 3, Ogilvie teaches the method of claim 1, wherein said message originating from said recipient is a forward of said email message (see col. 9).

As to claim 4, Ogilvie teaches the method of claim 1, wherein said excluded content comprises the entirety of said email message (see col. 5-9, Ogilvie discloses that some or all of the content of a message can be self-removing).

As to claim 5, Ogilvie teaches the method of claim 1, said method further comprising:

inserting a control header into said email message to identify said excluded content (see figs. 2-3; col. 12, Ogilvie discloses that a header includes control code for identifying message content as self-removing content).

As to claim 6, Ogilvie teaches a method of controlling inclusion of email content comprising:

selecting at least one keyword; identifying as excluded content at least a portion of an email message comprising said at least one keyword (see col. 5-12, Ogilvie discloses that the message includes removal code and indicators within the content to be removed);

transmitting said email message to a recipient configured to exclude said excluded content from a message originating from said recipient (see col. 5-6, Ogilvie discloses that a message contains code identifying some or all of message content to be self-removing).

Claims 7-25 do not teach or define any new limitations above claims 1-6 and therefore are rejected for similar reasons.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Saleh Najjar whose telephone number is (703) 308-7613. The examiner can normally be reached on Monday-Friday from 6:30 to 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Ario Etienne*, can be reached on (703) 308-7562. The fax phone number for this Group is (703) 308-9052.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600. The fax number for the After-Final correspondence/amendment is (703) 746-7238. The fax number for official correspondence/amendment is (703) 746-7239. The fax number for Non-official draft correspondence/amendment is (703) 746-7240.

A handwritten signature in black ink, appearing to read 'Saleh Najjar', with a stylized, flowing script.

Saleh Najjar

Primary Examiner / Art Unit 2157